REMARKS

Claims 1-55 stand rejected. Reconsideration of the application in view of the remarks set forth below is respectfully requested.

Rejections Under 35 U.S.C. § 102

The Examiner rejected claims 1-10, 12-21, 23-33 and 35-55 under 35 U.S.C. § 102(e) as being anticipated by Yanagisawa (U.S. Pat. No. 6,519,669). The Examiner's rejections are too lengthy to be reproduced efficiently herein. However, Applicants respectfully traverse these rejections for at least two reasons discussed in further detail below. First, the Yanagisawa reference does not disclose switching control of a bus. Second, the Yanagisawa reference does not disclose isolating or disconnecting a first bus controller from the bus, much less isolating/disconnecting a first bus controller from a bus in response to the detection of a signal indicating the coupling of a second bus controller to the bus.

Anticipation under Section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under Section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under Section 102, a single reference must teach each and every element or step of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Thus, if the claims recite even one element not found in the cited reference, the reference does not anticipate the claimed invention.

The present application is directed to a system and method of automatically switching control of a bus in a processor-based device. Pg. 2, lines 7-8. While certain system

motherboards may include a controller for controlling devices on a bus, such as a SCSI controller for controlling SCSI devices, many end-users may desire incorporation of alternate controller cards which provide different or additional features. Pg. 3, line 21-Pg. 4, line 2. Accordingly, in one exemplary embodiment, to enable a user to install an alternative controller on an expansion card via an I/O port, the locally resident bus controller is coupled to a switch/terminator module to automatically switch control of the bus and the devices on the bus from the locally resident bus controller to a bus controller on an expansion card whenever an expansion card is connected to the expansion port. Pg. 8, line 20 - Pg. 9, lines 1-4. When an expansion card is connected to the system motherboard, the locally resident bus controller is isolated/disconnected from the bus such that a controller on the expansion card assumes control of the bus and the devices on the bus. Pg. 10, lines 1-3.

In one exemplary embodiment, when a SCSI expansion card is connected to the expansion port, a presence detect signal is automatically asserted, thereby indicating that the presence of the expansion board has been detected. Pg. 10, lines 8-11. When a SCSI expansion card is not connected to the expansion port, a switch couples the locally resident controller to the SCSI back plane, thereby enabling control of the SCSI devices by the locally resident SCSI controller. Pg. 12, lines 9-11. Conversely, when the SCSI expansion card is connected to the expansion port, the presence detect signal is asserted, which causes the switch to decouple the locally resident SCSI controller from the SCSI bus segment, thereby enabling control of the bus and the SCSI devices on the bus by a controller on the expansion card. Pg. 12, lines 15-21.

Each of the independent claims 1, 13, 21, 23, 35, 44, 52 and 53 of the present application recites a method or device for: 1) switching control of a bus from a first controller to a second controller; and/or 2) automatically isolating/disconnecting a first bus

controller from the bus, in response to a second bus controller being coupled to the bus (or in response to the generation of a detection signal indicating that a second controller has been coupled to the bus). Based on the similarity of the Examiner's rejections and the subject matter generally recited in the independent claims, these points will be discussed together. While the specific recitations may vary with regard to one or more specific independent claims, the discussion below is generally applicable to each of the independent claims.

In contrast, the Yanagisawa reference discloses a system for docking/undocking a computer system from a docking station while the computer system is in operation and without affecting operation of a bus. Col. 1, lines 8-12. Among the objects disclosed in the Yanagisawa reference, there is provided a connecting apparatus and method for hot docking/undocking in which there is no need to provide a device for acquiring the ownership of a bus for docking/undocking. Col. 3, lines 8-11. To address this object, the Yanagisawa references discloses a bus switch 60 which, under the control of a bus switch control circuit 61, connects and disconnects a PCI bus 16 from a docking connector 150. The docking connector 150 is configured to be coupled to a docking station 200 to provide expanded functions to the computer 100. Col. 5, lines 7-12; Col. 5, line 64-Col. 6, line 4.

With regard to the first point above, the Yanagisawa reference *does not* disclose switching control of a bus from a first bus controller to a second bus controller, as recited in the present claims. Indeed, the Yanagisawa reference is essentially silent on control of the PCI bus 16. As described above, the Yanagisawa reference simply provides a switch 60 configured to couple the PCI bus 16 to a docking station which may be implemented to expand the functionality and applications implemented on the PCI bus 16 by allowing other devices to be coupled to the PCI bus 16. There is virtually no discussion in the Yanagisawa reference regarding control of the PCI bus 16, and there is no discussion in the Yanagisawa

reference regarding switching control of the PCI bus 16 from one bus controller to another. Independent claims 1, 13, 21 and 44 explicitly recite "switching control of a bus." Further, this feature is at least implicitly recited in independent claims 23, 35, 52 and 53. Accordingly, for this reason alone, the Yanagisawa reference cannot possibly anticipate the recited subject matter.

Further, and with regard to the second point, the Yanagisawa reference *does not* disclose isolating or disconnecting a first bus controller from the bus, much less doing so automatically in response to a second bus controller being coupled to the bus (and/or in response to a detection signal indicating that a second bus controller has been coupled to the bus), as recited in each of the independent claims. Indeed, as described above, the Yanagisawa reference simply discloses a switch 60 for connecting the PCI bus 16 to a docking station. The switch 60 may be opened by the switch control circuit to allow for expansion of the PCI bus 16 through the expansion connector 150. In contrast to the subject matter recited in the present claims, the Yanagisawa reference does not disclose isolating/disconnecting a first bus controller from the bus in response to the connection of a second bus controller being coupled to the bus or isolating/disconnecting a first bus controller from the bus in response to a detection signal generated in response to a second bus controller being coupled to the bus. As previously discussed, the Yanagisawa reference does not even discuss bus control much less isolating or disconnecting one controller from the bus in response to a second controller being coupled to the bus. Accordingly for this further reason, the Yanagisawa reference cannot possibly anticipate the subject matter recited in the present claims.

For at least the reasons set forth above, it is clear that the present claims recite elements that are not disclosed in the Yanagisawa reference. Accordingly, the subject matter

recited in independent claims 1, 13, 21, 23, 35, 44, 52 and 53, as well as those claims dependent thereon, cannot possibly be anticipated by the Yanagisawa reference. As such, Applicants respectfully request withdrawal of the Examiner's rejections under 35 U.S.C. § 102 (e) and allowance of claims 1-10, 12-21, 23-33 and 35-55.

Rejections Under 35 U.S.C. § 103

The Examiner rejected claims 11, 22, and 34 under 35 U.S.C. § 103 (a) as being unpatentable over Yanagisawa in view of Applicants Admitted Prior Art ("AAPA"). The rejected claims each depend from independent claims which, for the reasons set forth above, include subject matter which is not disclosed by the Yanagisawa reference. Applicants note that the AAPA does nothing to cure the deficiencies discussed above with respect to the Yanagisawa reference. Accordingly, Applicants submit that claims 11, 22 and 34 cannot be rendered obvious by the cited combination and respectfully request withdrawal of the rejection of claims 11, 22 and 34 under 35 U.S.C. § 103 (a).

Conclusion

In view of the remarks set forth above, Applicants respectfully request allowance of claims 1-55. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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